

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-34 are pending in the above-identified application and are each amended by the present amendment. Applicants respectfully submit that support for amended claims 1-34 is self-evident from Applicants' originally-filed disclosure, including the claims and the specification from page 6, line 32, to page 7, line 6; at page 7, lines 17-32; and at page 8, lines 22-25. As such, no new subject matter is introduced by the foregoing amendment.

The Office Action rejected claims 11-18 under 35 U.S.C. §112, second paragraph. Further, claims 8-18 were objected to under 37 C.F.R. §1.75. In addition, claims 1-7 and 19-34 were rejected under 35 U.S.C. §103(a) as unpatentable over EP 0786915 A2, (hereinafter "EP '915") in view of WO 94/30023; (hereinafter "WO '023").

Regarding the rejection under 35 U.S.C. §112, second paragraph, and the objection under 37 C.F.R. § 1.75, Applicants respectfully submit that the Preliminary Amendment submitted on May 5, 2000, eliminated all multiple dependencies in the claims. Specifically, the claims were amended by the Preliminary Amendment such that each of the pending claims directly depends from only one other claim. Attached herewith is a copy of the Preliminary Amendment filed on May 5, 2000, along with a copy of the associated date-stamped filing receipt. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 11-18 and the objection of claims 8-18 in light of the Preliminary Amendment.

In response to the rejection of claims 1-7 and 19-34 under 35 U.S.C. §103(a), Applicants respectfully submit that EP '915 and WO '023 fail to render obvious these claims. For example, amended independent claim 1 is drawn to an identification card that includes, among other features, a memory area including:

...a first identification parameter for identification of the subscriber in the mobile radio network,
a second identification parameter for identification of the subscriber in another system that is not a mobile radio network, the second identification parameter including a parameter that is specific to the other system, and
a system-dependent identification protocol program configured to introduce to the other system the second identification parameter according to a system-specific identification protocol.

Referring to the non-limiting example of Applicants' Figure 1, a SIM card 1 includes a microcontroller 10 provided with a memory area.¹ The memory area includes tables 101 and/or table 102, which store identification parameters specific to different systems, such as a GSM network, a pay-TV system, or a network computer (NC) system.² Such different identification parameters can be stored in different tables, such as the tables 101, or in a single table, such as the table 102.³ In this way, the SIM card 1 can be used in different systems, including non-mobile radio network systems.⁴

Further, certain identification parameters can be introduced to a system according to a predetermined protocol, as required. In this case, the SIM card 1 executes a system-dependent identification protocol program to introduce the identification parameters to the system in accordance with the protocol for identification purposes.⁵

EP '915 and WO '023 do not disclose or suggest amended claim 1. For example, EP '915 depicts IC devices that allow a roaming mobile device to be used in different mobile networks 1, 2, and N.⁶ An IC device can include a master file (MF) 901, which stores a mobile terminal ID number MTIDN₁ in an elementary file (EF) 113 and in an EF 151. The EF 113 and the EF 151 are respectively associated with different mobile networks, such that the mobile device connected to the IC device can be used in the different mobile networks.⁷

¹ See Applicants' specification at Figure 1 and at page 4, lines 8-12.

² See *id.* at Figure 2.

³ See *id.* at Figure 2 and from page 6, line 18, to page 7, line 6.

⁴ See *id.* at page 7, lines 7-16.

⁵ See *id.* at page 7, lines 17-32.

⁶ See EP '915 at Figure 1 and at page 3, lines 40-46.

⁷ See *id.* at Figure 8 and at page 5, lines 40-43.

However, as correctly acknowledged in the Office Action, EP '915 does not teach "utilizing the SIM in an environment that is not a radio network."⁸ Specifically, EP '915 does not depict a memory area of an identification card including a first identification parameter for identification in a mobile radio network and a second identification parameter for identification in another system that is not a mobile radio network, as recited in amended claim 1. Rather, the IC device of EP '915 only stores a single mobile terminal ID number in multiple locations on the IC device to allow identification in different mobile network.

Further, EP '915 does not depict a memory area of an identification card storing a system-dependent identification protocol program configured to introduce to another system a second identification parameter according to a system-specific identification protocol, as recited in amended claim 1. EP '915 is completely silent as to this feature. For example, the IC device of EP '915 does not store a system-dependent identification protocol program that introduces a second identification protocol to a non-mobile radio network system according to a system-specific identification protocol.

As such, EP '915 fails to teach each and every feature of amended claim 1. The Office Action turns to the teachings of WO '023 to remedy the deficiencies of EP '915 with respect to amended claim 1. However, WO '023 fails to teach the features of amended claim 1 not taught by EP '915.

For example, WO '023 depicts a SIM card 7 that is capable of storing SMS data received via SMS messages.⁹ In addition to storing telephone numbers, the SIM card 7 is also capable of storing a subscriber's credit information¹⁰ and of acting as a multi-service card (e.g., acting as a credit card, passport, etc.).¹¹ Particular stored information, such as

⁸ Office Action mailed July 2, 2004, at numbered paragraph 5.

⁹ See WO '023 at Figures 1 and 3.

¹⁰ See *id.* at page 6, lines 5-17.

¹¹ See *id.* at page 10, lines 10-27.

credit card information, can only be accessed from the SIM card 7 when a PIN number is entered by the subscriber.¹²

However, WO '023 does not disclose or suggest that the SIM card 7 includes a memory area storing a second identification parameter for identification of the subscriber in another system that is not a mobile radio network, the second identification parameter including a parameter that is specific to the other system, as recited in amended claim 1. Rather, the SIM card 7 of WO '023 stores financial information that can be accessed when a PIN number is entered in the associated mobile device. The financial information, however, is not a second identification parameter that is used to identify the subscriber in another system that is not a mobile radio network. Instead, the financial information is transmitted from the SIM card 7 only after the identification of the subscriber is already known in the GSM network. In addition, although WO '023 indicates that the SIM card 7 can be used as a multi-service card, this teaching does not disclose or suggest the storing of a second identification parameter, as recited in amended claim 1.

Further, WO '023 does not depict a memory area of an identification card storing a system-dependent identification protocol program configured to introduce to another system a second identification parameter according to a system-specific identification protocol, as recited in amended claim 1. WO '023 is, instead, completely silent as to this feature. For example, the SIM card 7 of WO '023 does not store a system-dependent identification protocol program that introduces a second identification protocol to a non-mobile radio network system according to a system-specific identification protocol.

As such, WO '023 fails to remedy the deficiencies of EP '915 with respect to amended claim 1. Accordingly, EP '915 and WO '023 fail to teach or suggest amended claim 1, and Applicants respectfully submit that amended claim 1 is patentable over EP '915

¹² See *id.* at page 6, lines 6-12.

and WO '023. Therefore, for at least the reasons discussed above, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a). Further, Applicants respectfully submit that amended claims 2-18, which depend from amended claim 1, are also patentable for at least the above-discussed reasons.

Amended claim 19 is drawn to a mobile radio system that includes, among other features, features substantially similar to those discussed above with respect to amended claim 1. As such, for at least the reasons discussed above with respect to amended claim 1, Applicants respectfully submit that amended claim 19 also patentably defines over EP '915 and WO '023. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §103(a). Amended claims 20-29 depend from amended claim 19 and, for at least the above-discussed reasons, are also patentable.

Amended claim 30 recites:

- ...storing in a server an identification parameter and a system-specific identification protocol program, with which the subscriber can be identified in another system that is not a mobile radio network;
- communicating the identification parameter and the system-specific identification protocol program from the server to an identification card of the subscriber via the mobile radio network, the identification card being coupled through a contact area of the identification card to a mobile device, and the identification card having a memory area including a network identification parameter of the subscriber for the mobile radio network;
- storing the identification parameter and the system-specific identification protocol program in the memory area; and
- using the identification card to identify the subscriber in the other system, the system-specific identification protocol program introducing to the other system the identification parameter according to a system-specific identification protocol.

The suggested combination of EP '915 and WO '023 fails to render obvious amended claim 30. For example, neither EP '915 nor WO '023 depicts the communication of an identification parameter and a system-specific identification protocol program from a server to an identification card via a mobile radio network, where the system-specific identification protocol program introduces to a system other than the mobile radio network the

Application No. 09/530,867
Reply to Office Action of July 2, 2004

identification parameter according to a system-specific identification protocol. EP '915 and WO '023 are completely silent as to these features.

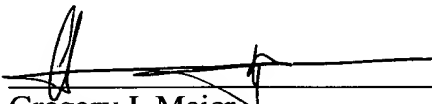
As such, Applicants respectfully submit that amended claim 30 also patentably defines over EP '915 and WO '023, and, accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 30 under 35 U.S.C. §103(a). Amended claims 31-34 depend from amended claim 30 and, for at least the above-discussed reasons, are also patentable.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested. Further, Applicants respectfully request that the Examiner contact the undersigned to discuss the differences between the cited references and the amended claims.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Chien H. Yuan
Registration No. 48,056



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 06/04)

JJK/CHY:pch

I:\ATTY\CHY\236113US\236113 AM 04OCT04.DOC

James J. Kulbaski
Registration No. 34,648